

Remarks

In the outstanding Office Action, the Examiner has rejected claims 1-17, 19-25, 27-34, 36-41 and 43-52 under 35 U.S.C. §102(e) as being anticipated by United States Publication No. 2001/0006892, published in the names of Barnett et al. (hereinafter "Barnett"). The Examiner has rejected claims 18, 26, 35 and 42 under 35 U.S.C. §103(a) as being unpatentable over Barnett in view of United States Patent No. 6,282,412, issued in the name of Lyons (hereinafter "Lyons").

Claims 1-52 were originally presented for Examination. Claims 1-52 are currently pending, of which, claims 1, 10, 21, 29, 38 and 52 are in independent form. Favorable reconsideration of the present Response as currently constituted is respectfully requested.

Rejections Under 35 U.S.C. §102(e)

Claims 1-17, 19-25, 27-34, 36-41 and 43-52 have been rejected under 35 U.S.C. §102(e) as being anticipated by Barnett. Applicant respectfully submits herewith a supplemental Declaration of Lawrence R. Youst. This declaration, in combination with the declarations submitted in connection with the prior response, establish invention of the subject matter of the above-captioned application in the United States at a date prior to February 16, 2001, i.e., the effective date of Barnett and reasonable diligence

of the completion of the invention from the time of conception, to a time just prior to the date of Barnett, up to the filing of the instant application on August 8, 2001. Accordingly, Applicant respectfully submits that the §102(e) rejections are rendered moot. Further, Applicant respectfully requests withdrawal of the outstanding §102(e) rejections and allowance of claims 1-17, 19-25, 27-34, 36-41 and 43-52.

Showing of Reasonable Diligence under 37 C.F.R. 1.131

The total period of time elapsed from the reference date of Barnett to the filing date of the present application is approximately 6 months. Although a showing of reasonable diligence does not have a specific timetable, Applicant respectfully submits that the short period of time elapsed is, itself, evidence of reasonable diligence on the part of Applicant. It is well-established that proof of reasonable diligence does not require a party to work constantly on the invention or to drop all other work. See, e.g., *Bey v. Kollonitsch*, 806 F.2d 1024, 1028, 231 USPQ 967, 970 (Fed. Cir. 1986) (Federal Circuit found reasonable diligence where eighteen months elapsed from the time of submittal to attorney and filing of case). The question to be answered is whether the inventor was pursuing his goal in a reasonably continuous fashion. See, e.g., *Monsanto Co. v. Mycogen Plant*

Science, Inc., 61 F. Supp. 2d 133, 184 (D. Del. 1999), later appeal, 261 F.3d 1356, 59 USPQ2d 1930 (Fed. Cir. 2001).

Reasonable gaps in continuous activity are not fatal to a showing of reasonable diligence. The question is not necessarily whether the inventor undertook the most expeditious course to reduction to practice, so long as there was reasonably diligent activity toward the end in view. *De Solms v. Schoenwald*, 15 USPQ2d 1507, 1511 (Bd. Pat. App. & Int'f 1990). The six month period at issue here is nothing like the period in *Kollonitsch*, in which eighteen months were expended in the drafting of the applications or the four years in *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1579, 38 USPQ2d 1288, 1292 (Fed. Cir. 1996). In both of these cases, reasonable diligence was found to be present even though there were gaps in continuous activity.

In the present case, Inventor Tsubaki had conceived of the invention by early February, 2001. Inventor Tsubaki's notes indicate that he had recorded his conception in documents dated January 23, 2001 and February 1, 2001. See Declaration of Arthur Tsubaki ("Tsubaki Dec."), para. 8, Exh. A, B. Although Mr. Tsubaki's notes do not necessarily record conception of every detail recited in the presently-pending claims, such level of detail is not required, so long as the recorded detail is sufficient to make the claimed invention apparent to one of skill

in the art. See, e.g., *In re Spiller*, 500 F.2d 1170, 1176, 182 USPQ 614, 618, 619 (CCPA 1974).

After his conception of the invention in late January, Mr. Tsubaki conducted feasibility discussions with other company personnel during the month of February. See Declaration of Arthur Tsubaki ("Tsubaki Dec."), para. 8. On or about February 27, less than two weeks after the reference date of Barnett, Mr. Tsubaki presented the concept to management for approval. Tsubaki Dec., para. 9. Subsequent to that presentation, Mr. Tsubaki performed a preliminary engineering and product feasibility study and prepared a more detailed presentation relating to the product direction of frequency scanning radio receivers including the GPS scanner concept. Tsubaki Dec., para. 10. On or about April 28, 2001, Mr. Tsubaki made a formal presentation to company management regarding the product direction of frequency scanning radio receivers including the GPS scanner concept. At this time, the GPS scanner concept was approved for future technology implementation and legal review. Tsubaki Dec., para. 11.

Between April 29, 2001 and May 14, 2001, Mr. Tsubaki met with Brianna Hinojosa-Flores, Intellectual Property Coordinator at Uniden regarding the GPS scanner concept and acquisition of patent protection for the GPS scanner concept. Tsubaki Dec., para. 12. By June 1, 2001, Mr. Tsubaki had drafted a formal invention disclosure, which was submitted to outside counsel on June 19,

2001. See Declaration of Lawrence R. Youst ("Youst Dec."), para. 4.

Between June 19, 2001 and July 16, 2001, Mr. Youst prepared, in his normal course of business, a draft of the patent application relating to the present invention including reviewing the invention disclosure, reviewing the prior art patents, preparing informal drawings, overseeing the preparation of formal drawings and drafting of the patent application. See Youst Dec., para. 6. During the same period, Mr. Youst completed and filed five other patent applications which had been received prior to receipt of the present application and was in the process of preparing at least twelve other patent applications in addition to preparing at least six amendments relating to previously filed patent applications. See Youst Dec., para. 6.

On July 16, 2001, Mr. Youst forwarded a draft of the patent application relating to the present invention to Uniden for review by the inventors. Youst Dec., para. 8. Between July 16, 2001 and August 7, 2001, Mr. Youst received comments from the inventors and updated the patent application. Mr. Youst also prepared the Declaration and Power of Attorney. Youst Dec., para. 9.

On August 7, 2001, Mr. Youst obtained the inventors' written comments along with the executed Declaration and Power of Attorney of the inventors. Youst Dec., para. 10. On August 8, 2001, Mr. Youst filed the present patent application, which was granted

serial number 09/924,788 and a filing date of August 8, 2001. Youst Dec., para. 11.

Upon a review of the above, it is clear that the invention proceeded from conception to constructive reduction to practice in a reasonably diligent fashion. Each step in the process was undertaken promptly and in a manner consistent with the normal course of business. Once the invention disclosure was approved and forwarded to Mr. Youst, he took up the disclosure, prepared a draft, and forwarded the draft to the inventor in a prompt and efficient manner. Accordingly, Applicant respectfully submits that the facts compel a finding that the application was filed in a reasonably diligent manner, consistent with the requirements of 37 C.F.R. 1.131.

Rejections Under 35 U.S.C. §103(a)

Claims 18, 26, 35 and 42 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Barnett in view of Lyons. In each of the §103(a) rejections, the Examiner relies on Barnett, which is prior art under 35 U.S.C. §102(e). As stated above, Applicant conceived prior to the filing of the Barnett reference and acted with reasonable diligence toward the completion of the invention from the time of conception, to a time just prior to the date of Barnett, up to the filing of the instant application on August 8, 2001. Accordingly, Applicant respectfully submits that

the §103(a) rejections are rendered moot. Further, Applicant respectfully requests withdrawal of the outstanding §103(a) rejections and allowance of claims 18, 26, 35 and 42.

Fee Statement


Applicant has enclosed herewith a Form PTO-2038 authorizing payment in the amount of \$120.00 for a one-month extension of time. Compared to the initial filing, in the present Response, the number of independent claims has remained the same and the total number of claims has remained the same. Applicant believes no additional fees are due for the filing of this Response. If any additional fees are due or overpayment have been made, please charge or credit, our Deposit Account No. 03-1130.

Conclusion

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the outstanding objections and rejections and allow claims 1-52 presented for reconsideration herein. Accordingly, a favorable action in the form of an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned for any reason that would advance the instant application to issue.

Dated this 3rd day of October, 2005.

Respectfully submitted:



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